

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RYUJI ISHIGURO, ITARU KAWAKAMI, MITSURU TANABE,
YUICHI EZURA, ICHIRO SATO, and MUNETAKE EBIHARA

Appeal 2007-1698
Application 09/869,164¹
Technology Center 2100

Decided: November 8, 2007

Before ALLEN R. MACDONALD, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed June 25, 2001. Application is a national stage entry of PCT/JP00/07472, filed 10/25/00 and claiming priority in Japan to 10/25/00. The real party in interest is Sony Corp.

STATEMENT OF CASE

Appellants appeal from a Final Rejection of claims under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). An oral hearing on this appeal was conducted on October 24, 2007.

Appellants' invention relates to an apparatus and method for converting the format of using condition information (sometimes called digital right management data) that is related to content data, such as recorded music. In the words of the Appellants:

There are a number of contents distributors furnishing the music contents, with the encryption system of the music contents or the statement format of the using condition information differing from one contents purveyor to another. So, the user has to purchase the player application for downloading or reproduction for each contents purveyor to reproduce the music contents in accordance with the pre-set player application.

It is therefore an object of the present invention to provide a contents data control apparatus which enables plural contents present on e.g., a sole personal computer to be handled in a unified fashion, as the protection of the copyrights for the contents is maintained.

(Spec. 2 and 3).

Claim 26 is exemplary:

26. An apparatus for managing using condition information corresponding to content data, comprising:

a receiver configured to receive said using condition information described in a first format, the using condition information indicating usage rules corresponding to the content data; and

a converter configured to convert said first format of said using condition information into a second format, said second format being different from the first format.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Benson	US 5,845,281	Dec. 1, 1998
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Rejections:

Claims 1 to 3 and 19 to 33 stand rejected under 35 U.S.C. § 102(b) for being anticipated by Benson.

All claims stand or fall together, with claim 26 as exemplary.

Appellants contend that the claimed subject matter is not anticipated by Benson, for failure of Benson to recite all elements of the claim. The Examiner contends that the claims are properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not

to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).²

We affirm the rejection.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(b). The issue turns on whether Benson teaches converting using condition information from one format to another.

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented an apparatus for distributing music or other types of data content received at a user's personal computer (PC) from a variety of Electronic Music Distributor (EMD) servers (Fig. 1, 4-1 to 4-3). The invention downloads the music from the PC to the user's portable devices (Figure 1, 6-1 to 6-3; Spec. 11, middle) connected to it. Each piece of content (music) has associated with it using condition information, including the number of times the music may be downloaded to portable devices, which varies from one music EMD to another. (Spec. 2, l. 3; page 11, middle). To accommodate various EMDs, the invention converts the format of the music as well as the using condition information to a common format for ease of management of the system. (Spec. 6, top). This application focuses on converting the using condition information from one format to another. (Claim 26).

2. Examiner rejects the claims based on an anticipation by the Benson reference. Benson teaches a method and system for managing the distribution of books, films video, music and other items he calls data objects. (Col. 1, l. 37). Data objects (#24) have associated usage conditions (#42) with which they are commonly packaged. (Col. 5, l. 25). In the packaging process, the data object is linked with other data (e.g., an identifier, a title, a format used for reformatting the data object, and other such data) and placed in a sub-package called a header. (Col. 7, l. 56). Usage information (conditions for usage of the data object) is associated with, but not part of the header. (Col. 7, l. 68) and becomes part of a usage data file. The packaging module then applies format changes, if required, to the data object. (Col. 8, l. 14).
3. Continuing the process from FF2 just above, the packaging module of Benson is described as concatenating the usage data file, and the data object (music), and stores the result as a temporary file in step 414 (Fig. 4; Col. 8, l. 15). Then in step 415 the temporary file is encrypted by encryption module 305. (Col. 8, l. 18).

PRINCIPLES OF LAW

On appeal, Appellants bear the burden of showing that the Examiner has not established a legally sufficient basis for the rejection of the claims.

“In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Both anticipation under 35 U.S.C. § 102 and obviousness under § 103 are two-step inquiries, in which the first step is a proper construction of the claims and the second step requires a comparison of the properly construed claim to the prior art. *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003).

“Shortly after the creation of this court, Judge Rich wrote that “[t]he descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims.” *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985). On numerous occasions since then, we have reaffirmed that point...” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005).

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states that “the words of a claim ‘are

generally given their ordinary and customary meaning.” *Phillips v. AWH Corp.*, 415 F.3d at 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The “ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Id.* at 1313.

However, our reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

“This case, however, is dissimilar from *Gulack*. There the printed matter and the circularity of the band were interrelated, so as to produce a new product useful for “educational and recreational mathematical” purposes. Here, addition of a new set of instructions into a known kit does not interrelate with the kit in the same way as the numbers interrelated with the band. In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result. Here, the printed matter in no way depends on the kit, and the kit does not depend on the printed matter.” *In re Ngai*, 367 F.3d at 1339 (Fed. Cir. 2004).

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 1 to 3, and 19 to 33 under 35 U.S.C. § 102(b). Reviewing the findings of facts and the documents of record, and with due deference to the arguments raised by Appellants in the oral hearing of October 24, 2007, we find that the Examiner has established a prima facie case for the rejection. (See Answer, 3 to 5.)

In opposition to this case, Appellants argue that the Benson reference fails to teach a key limitation of the representative claim, namely that “Benson does not describe or suggest that format module 1406 converts the first format of the **using condition information** into a second format.” (Br. 8 top.)

First Consideration

In carefully reviewing Benson, we agree that only the data object (music) in Benson is described as undergoing a format change by the format module. The usage information appears to retain its format in the processing of Benson noted by Appellants. (See FF #2 above).

However, as noted in FF #3 above, the temporary file, which includes both the data object and the usage data file, is encrypted. Encryption is a process that performs a number of transformations to the usage data, including changing its format. Appellants, in their Brief (page 9, top, and footnote 22) anticipate this argument, and mention that they also perform an

encryption process, and thus this distinguishes the use of the term from applying to format changes.

We have carefully reviewed the use of the term encryption in the Specification, especially noting the citations mentioned in Appellants' footnote 22. (Br. 9). On pages 5 and 6, the Specification recites how the application for reproduction or the comprehensive contents management unit converts **content**, encrypted by the application, and the **format of the using condition information**, into **content** encrypted as the comprehensive content management unit requires, and the **format of the using condition information**. These elements are converted to a unified format for the contents data encryption system and the using condition information. Likewise on pages 48 and 52, we see a format change applied to encrypted data as well as to the using condition information. Do these referenced sections of the Specification particularly define "format change" so it no longer includes encryption? We find the answer to that issue to be "no". An encryption is one particular type of format change. The noted sections of the Specification merely recite that contents which have undergone one type of format change (encryption) can undergo further format changes. There is no definition in the Specification that redefines encryption so that it can no longer be considered one type of format change. In *Phillips* (cited above), the court cautions:

"The Texas Digital court further explained that the patent's specification and prosecution history must be consulted to determine if the patentee has used "the words [of the claim] in a manner clearly

inconsistent with the ordinary meaning reflected, for example, in a dictionary definition.” 308 F.3d at 1204. The court identified two circumstances in which such an inconsistency may be found. First, the court stated, “the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning.” Id. Second, “the presumption also will be rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.” Id.

The Texas Digital court explained that it advanced the methodology set forth in that opinion in an effort to combat what this court has termed “one of the cardinal sins of patent law—reading a limitation from the written description into the claims,” SciMed Life Sys., 242 F.3d at 1340. The court concluded that it is improper to consult “the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves.” Texas Digital, 308 F.3d at 1204. To do so, the court reasoned, “invites a violation of our precedent counseling against importing limitations into the claims.” Id.”

Phillips v. AWH Corp., 415 F.3d at 1319-20 (Fed. Cir. 2005).

In consideration of that reasoning, we first note that *Phillips* criticizes the *Texas Digital* decision for its reliance on dictionaries and its statement that the definition must be express. (*Id.* at 1321). However, even allowing for an implicit definition, we do not find evidence in the instant

Specification redefining encryption in a way that excludes or obviates the fact that encryption involves, and is one form of, a format change.

We thus find that Benson does teach that “using condition information” may be converted from one format to a second format, as claimed since such information is encrypted in Benson.

Second Consideration

We have carefully considered exemplary claim 26, reproduced again:

26. An apparatus for managing using condition information corresponding to content data, comprising:

a receiver configured to receive said using condition information described in a first format, the using condition information indicating usage rules corresponding to the content data; and

a converter configured to convert said first format of said using condition information into a second format, said second format being different from the first format.

The structure of the claim, from a diagrammatic point of view, is as follows:

26. An apparatus for managing [a type of information, called X] that corresponds to content data, comprising:

- a receiver configured to receive [X] in a first format, [X] indicating rules corresponding to content data; and
- a converter configured to convert said first format of [X] into a second format ...

It appears to us that the subject matter presented in the representative claim on appeal relates to features that may differ from the prior art solely on the basis of “non-functional descriptive material” (i.e., what the information X indicates), which is generally not given patentable weight when determining patentability of an invention over the prior art. From *In re Gulack*, 703 F.2d at 1385 (Fed. Cir. 1983) we appreciate that the USPTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384; *see also Diamond v. Diehr*, 450 U.S. 175, 191 (1981). However, the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed Cir. 1994); *In re Ngai*, 367 F.3d at 1338 (Fed. Cir. 2004).

In the instant case, [X], the “using condition information”, is merely described as corresponding to another type of data (content data) or indicating rules corresponding to that other type of data. The function of the conversion system is not affected in any way by what [X] is or does. [X] is non-functional language, and need not be given patentable weight if challenged under 35 U.S.C. § 102(b) by a reference that performs a format conversion of any data to another format.

In the instant case, the prior art Benson describes all the claimed structural and functional relationships between the parts of the claimed apparatus, but Benson describes the process with different data. In

particular, Benson performs a format conversion from one format to another, but with data that represents the content. Since one piece of data acts like another with respect to format conversion, the nature of the data is non-functional and will not be given any patentable weight.

On this second basis we again find that Benson anticipates the claim, and the rejection under 35 U.S.C. § 102(b) shall be sustained.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 3, and 19 to 33.

DECISION

The Examiner's rejection of claims 1 to 3, and 19 to 33 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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